


Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

| | | | |
|---|--|---|---|
| PRE-APPEAL BRIEF REQUEST FOR REVIEW | | Docket Number (Optional) 67134-5038 | |
| I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>May 31, 2007</u> Signature <u>[Electronically Filed]</u> Typed or printed name <u>Robert Fiore</u> | | Application Number 09/872,353 | Filed June 1, 2001 |
| | | First Named Inventor Brian R. McCarthy | |
| | | Art Unit 3630 | Examiner Alicia Ann Chevalier |
| Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. | | | |
| This request is being filed with a notice of appeal. | | | |
| The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided. | | | |
| I am the | |  Signature Douglas N. Larson Typed or printed name | |
| <input type="checkbox"/> | applicant/inventor. | | |
| <input type="checkbox"/> | assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) | | |
| <input checked="" type="checkbox"/> | attorney or agent of record. Registration number <u>29,401</u> | (310) 785-5384 Telephone number | |
| <input type="checkbox"/> | attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____ | May 31, 2007 Date | |
| NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below. | | | |
| <input checked="" type="checkbox"/> | *Total of <u>1</u> forms are submitted. | | |

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

REMARKS/ARGUMENTS

Applicants respectfully request that the Final Rejection dated December 4, 2006 be reviewed by the Review Panel in advance of the filing of an Appeal Brief, that the Final Rejection be withdrawn following that review as there are clear errors in the Examiner's rejections and that the Notice of Allowance be promptly issued .

The Final Rejection

The Examiner in her Final Rejection rejected claims 314-409 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Specifically, the Examiner was unable to find support in the application as filed for the limitation "the ultraremovable adhesive . . . back surfaces [of the printed business cards] being non-tacky and the exposed portion of the liner sheet being tacky."

On page 5, the Examiner stated that "[t]here is no support for the 'adhesive' to have a back surface being non-tacky and the exposed portion of the liner being tacky." (Emphasis added.)

The Response After Final Rejection

Applicants in their Response pointed out that the statement quoted above from page 5 of the Final Rejection that the claims state that the back surface of the ultraremovable adhesive is non-tacky is an incorrect interpretation of the claims. Rather, it is the back surface of the business cards (and not the back surface of the adhesive) which is non-tacky.

The Advisory Action

In the Advisory Action, the Examiner agreed with Applicants' interpretation of the claims as set forth in the paragraph above. However, without further explanation or comment on the points made in Applicants' Response, the Examiner maintained her position that the claims were unpatentable under Section 112, first paragraph.

Discussion

Applicants respectfully contend that the rejections of record are clearly not proper and without basis, for reasons set forth below. Each of the independent claims includes

the following paragraph:

[T]he ultraremovable adhesive allowing the printed business cards to be removed from the liner sheet and from the matrix waste portion and into individual printed business cards with the ultraremovable adhesive remaining on the liner sheet and not on back side surfaces of the printed business cards and thereby the back side surfaces being non-tacky and the exposed portion of the liner sheet being tacky[.]

In other words, the issue in this appeal is whether there is support in the application as filed for the claim limitation that with the business cards in a removed position relative to the liner sheet the ultraremovable adhesive remains on the liner sheet and not on the back side surfaces of the business cards and thereby the back side surfaces are non-tacky and the exposed portion of the liner sheet is tacky.

This limitation is specifically disclosed in the application as filed in paragraphs [0023], [0104], original claim 63 and original claim 77. These paragraphs and claims are set forth below with emphasis added.

[0023] The ultraremovable adhesive is peeled off with the paper waste strips and the cover strips thereby providing a clean back side to the cardstock sheet (and thereby the printed media). The clean back side(s) (even when a coating thereon is provided) advantageously can be written on, that is, it accepts pencil, ink and even inkjet and laser printing. The ultraremovable adhesive sticks to the paper [the liner sheet] allowing for easy removal and disposal of the paper strips, and even though it [the liner sheet] is tacky it does not stick to anything permanently. In contrast, the "Paper Direct" product uses a removable adhesive. (Generally, adhesions of "ultraremovable . . . adhesives at their highest adhesion levels (to a surface such as stainless steel) are roughly half of what they are for conventional "removable" adhesive. A fundamental difference is that conventional adhesives provide complete contact with a substrate while ultraremovable adhesive provide partial contact. This limited contact area is what prevents an ultraremovable adhesive from becoming permanent, over time.) (Emphasis and bracketed material added.)

[0104] . . . Referring to FIG. 37, the liner strips 844 are preferably paper strips adhered to the facestock sheet with ultraremovable adhesive 848. The ultraremovable adhesive 848 can be the Fasson water-base acrylic suspension polymer (made per U.S. Pat. No. 5,656,705) or the CleanTac II adhesive available from Moore. As an example, the liner strips 844 can be 50# pre-primed uncoated litho paper (white or canary). (Emphasis added.)

63. A method of forming printed media, comprising:

(1) providing a printable media sheet construction including (a) a facestock sheet having through-cut lines separating the sheet into a plurality of printable media and (b) a plurality of paper strips attached with ultraremovable adhesive to a back face of the facestock sheet and over at least some of the through-cut lines and thereby holding the printable media together;

(2) separately feeding the printable media sheet construction off a stack of same via an automatic feed tray into a printer or copier and thereby conducting a printing operation on the printable media; and

(3) after the printing operation, separating the printed printable media from the paper strips off of the ultraremovable adhesive. (Emphasis and bolding added.)

77. The construction of claim 76 wherein the back side surfaces [of the business cards] are substantially tack-free after the facestock sheet is released from the liner sheet. (Emphasis and bracket material added.)

Further, Ronald Ugolick, Ph.D. declared the following in paragraphs 9, 11 and 12 of his Declaration dated September 13, 2006:

9. As is known to those skilled in the art, a removable adhesive is characterized by clean removability from a first surface with the sticky pressure-sensitive adhesive (psa) remaining on the opposing surface.

11. An example of an ultraremovable adhesive is that used in 3M's POST-IT notes. After removing one of these notes from a pad of same, applying the note (adhesive strip side down) to a surface and then later peeling the note off of the surface, the surface is left non-tacky, while the adhesive strip portion of the note remains tacky. (Emphasis added.)

12. Thus, an ultraremovable adhesive as would be known to those skilled in the art from the present application allows the printed business cards to be removed from the liner sheet with the back side surfaces of the business cards being non-tacky and the exposed portion of the liner sheet being tacky. This subject matter was described in the specification in sufficient detail as to reasonably convey to those skilled in the art that the inventors possessed the claimed invention at the time the application was filed. (Emphasis in original.)

Additionally, as a practical matter as would be understood by those skilled in the art, the business cards as disclosed in the present application should not have tacky back surfaces.

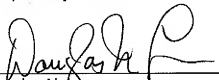
Concluding Remarks

Accordingly, no *prima facie* case of unpatentability has been made, and withdrawal of the Final Rejection and issuance of the Notice of Allowance at an early date are in order.

If there are any remaining issues, the Examiner is encouraged to telephone the below-signed counsel for Applicants at (310) 785-5384 to seek to resolve them.

The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. 10-0440. Should such additional fees be associated with an extension of time, Applicants respectfully request that this paper be considered a petition therefor.

Respectfully submitted,



Douglas N. Larson
Registration No. 29,401

Dated: May 31, 2007

JEFFER, MANGELS, BUTLER & MARMARO LLP
1900 Avenue of the Stars, 7th Floor
Los Angeles, CA 90067-4308
Telephone: (310) 203-8080
Facsimile : (310) 712-3371